

Serial No. 10/710,332
Attorney Docket No. 70655.3000

REMARKS

Applicants reply to the Final Office Action mailed on November 21, 2005, within two-months. Thus, Applicants request an Advisory Action, if necessary. Claims 1-17 were pending and the Examiner rejects claims 1-17. In reply, Applicants amend claims 1, 4, and 16, cancel claim 17 without prejudice to filing one or more claims having similar subject matter, add claims 18-21 and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

DOUBLE PATENTING

The Examiner provisionally rejects claims 1-17 over claims 1-17 of co-pending Application Serial No. 10/708,839 (U.S. Patent Application No. 2004/0232224). While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this provisional non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

35 U.S.C. § 103 REJECTIONS

Claims 1-17 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Black, U.S. Patent Application No. 2005/0122209 ("Black") in view of U.S. Patent Application No. 2005/0098621 ("de Sylva"). Applicants respectfully traverse.

Applicants' amendment to independent claim 1 renders this rejection moot. As indicated by the Examiner in the Office Action dated November 29, 2005, regarding claim 11 of application no. 10/710,308, "verifying whether the sample is associated with a preset transaction limit" is non-obvious.

Neither Black, de Sylva, nor any combination thereof, discloses or suggests a method including at least "associating said proffered biometric sample with said user information and

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said smartcard information to create a data packet; and associating said proffered biometric sample with a preset transaction limitation," as recited in amended claim 1.

Accordingly, Applicants assert that claim 1 is patentable over the cited references. Claims 2-16 variously depend from claim 1 and contain all of the elements thereof, so Applicants assert that these claims are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Applicants have cancelled claim 17, rendering moot any rejection of that claim. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-16.

NEW CLAIMS 13-17

New claims 18-21 variously depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that new claims 18-21 are patentable over the cited references at least for the same reasons as set forth above, in addition to their own respective features.

CONCLUSION

Applicants respectfully submit that the pending claims (20 total, 1 independent) are in condition for allowance. Reconsideration of the application is thus requested. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

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